



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

10010683-1

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on 10/7/05Signature Stephanie RileyTyped or printed name Stephanie Riley

Application Number

09/903,331

Filed

7/11/01

First Named Inventor

Linda Bilsing

Art Unit

2173

Examiner

Tadesse Hailu

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record. 39,345

Registration number

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

Signature

David R. Risley

Typed or printed name

(770) 933-9500

Telephone number

10/7/05

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Confirmation Number: 8428

Bilsing, et al.

Group Art Unit: 2173

Serial No.: 09/903,331

Examiner: Tadesse Hailu

Filed: 7/11/01

Docket No. 10010683-1

For: **DIGITAL IMAGING SYSTEMS
WITH USER INTENT-BASED FUNCTIONALITY**

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The final Office Action mailed August 9, 2005 has been carefully considered. Claims 2, 4 - 9, 22 - 25, 27 - 28 and 32 - 37 remain pending. Please consider the following remarks.

AUTHORIZATION TO DEBIT ACCOUNT

It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account no. 08-2025.

REMARKS

I. Applicants' Declaration under 37 C.F.R. 1.131 has not been Considered

The Office Action (Paper No. 12) indicates that the Declaration filed on June 27, 2005 was considered but deemed ineffective for overcoming *Chen*. Applicants respectfully traverse. In particular, two Declarations have been submitted in this case pursuant to 37 C.F.R. 1.131. That is, a first such Declaration was filed on March 16, 2005 (Paper No. 8) in order to overcome *Lopaz*, which was cited in Paper No. 7. Applicants timely submitted a Declaration (a copy of the first page of which is attached hereto as Exhibit A) in order to swear behind *Lopaz*. That Declaration was deemed persuasive and *Lopaz* was removed.

A second such Declaration was filed on June 27, 2005 (Paper No. 10) in order to overcome *Chen*, which was cited in Paper No. 9. Applicants timely submitted a Declaration (a copy of the first page of which is attached hereto as Exhibit B) in order to swear behind *Chen*. That Declaration provided the same proof of conception and diligence as the first Declaration; however, this second Declaration was deemed unpersuasive.

The second Declaration submitted to swear behind *Chen* clearly sets forth that the subject matter of the '331 application was conceived before March 7, 2001. Specifically, the second Declaration states:

2. I, along with the other inventors, conceived the subject matter of the '331 application at least as early as ***March 7, 2001***. ***Before this date***, we filled out an invention disclosure form of the Hewlett-Packard Company, which documented our invention. A redacted copy of that invention disclosure form is attached hereto as Exhibit A (redacted to remove the dates).
(Second Declaration of *Bilsing, et al.*) (Emphasis added).

However, the Office Action indicates that the second Declaration fails to provide proof of conception prior to the critical date of *Chen*, which both the Office Action and Applicants agree is March 7, 2001 (the U.S. filing date of *Chen*). Notably, the Office Action indicates that the second Declaration submitted by Applicants states that conception of the

invention was "at least as early as April 30, 2001." (See Office Action, Paper No. 12 at page 2). This information, however, does not appear in the second Declaration submitted on June 27, 2005, but appears to correspond to Applicants' first Declaration that was submitted on March 16, 2005 in connection with a previous response. Therefore, since it appears that Applicants' second Declaration has not been properly reviewed, withdrawal of the final Office Action is respectfully requested for at least this reason.

II. Rejections Under 35 U.S.C. §102 and §103 are Improper

The Office Action indicates that claims 2, 4, 6 – 9, 22 – 25, 27 - 28 and 32 - 37 stand rejected under 35 U.S.C. §102(e) as being anticipated by *Chen* and that claim 5 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Chen* in view of *Os*. Applicants respectfully traverse the rejections. In particular, Applicants respectfully maintain that the use of *Chen* is improper for rejecting the pending claims, and that *Os* does not teach or reasonably suggest the limitations asserted in the Office Action as being taught by *Chen*. Therefore, Applicants respectfully request that the rejections be removed and that the claims be placed in condition for allowance.

Respectfully submitted,


David R. Risley, Reg. No. 39,345

IP Administration, Legal Department, M/S 35
Hewlett-Packard Company
P.O. Box 272400
Fort Collins, CO 80527-2400

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450,

on 10/7/05 . Stephanie Riley
Signature



DECLARATION UNDER C.F.R. §1.131

1. I, Linda M. Bilsing, along with Bruce Votipka and Sharon Kurz, employees of the Hewlett-Packard Company at the time of the invention, are the inventors of the subject matter disclosed in U.S. Patent Application 09/903,331 (the "'331 application")
2. I, along with the other inventors, conceived the subject matter of the '331 application at least as early as April 30, 2001. Before this date, we filled out an invention disclosure form of the Hewlett-Packard Company, which documented our invention. A redacted copy of that invention disclosure form is attached hereto as Exhibit A (redacted to remove the dates).
3. Upon information and belief, diligent efforts were maintained to protect the invention of the '331 application between the time of April 30, 2001 (the filing date of a reference relied upon by the Patent Office to reject claims of the '331 application) and July 11, 2001 (the filing date of the '331 application).
4. In this regard, Paul Qualey, Esquire of Thomas, Kayden, Horstemeyer & Risley corresponded with me, Linda Bilsing, and began preparation of a draft application for my review.
5. Upon information and belief, multiple draft applications were prepared, reviewed and revised. I, Linda Bilsing, approved the final draft of the application before it was sent to the Hewlett-Packard legal department for review.
6. Upon information and belief, the final draft of the application was sent to the Hewlett-Packard legal department for review.
7. Upon information and belief, after the Hewlett-Packard legal department approved the final draft of the application for filing, after which I again reviewed the application and signed the formal documents required for filing the application.

EXHIBIT A
PAGE 1 OF 1



DECLARATION UNDER C.F.R. §1.131

1. I, Linda M. Bilsing, along with Bruce Votipka and Sharon Kurz, employees of the Hewlett-Packard Company, are the inventors of the subject matter disclosed in U.S. Patent Application 09/903,331 (the "331 application").
2. I, along with the other inventors, conceived the subject matter of the '331 application at least as early as March 7, 2001. Before this date, we filled out an invention disclosure form of the Hewlett-Packard Company, which documented our invention. A redacted copy of that invention disclosure form is attached hereto as Exhibit A (redacted to remove the dates).
3. Upon information and belief, diligent efforts were maintained to protect the invention of the '331 application between the time of March 7, 2001 and July 11, 2001 (the filing date of the '331 application).
4. In this regard, Paul Qualey, Esquire of Thomas, Kayden, Horstemeyer & Risley corresponded with me, Linda Bilsing, and began preparation of a draft application for my review.
5. Upon information and belief, multiple draft applications were prepared, reviewed and revised. I, Linda Bilsing, approved the final draft of the application before it was sent to the Hewlett-Packard legal department for review.
6. Upon information and belief, the final draft of the application was sent to the Hewlett-Packard legal department for review.
7. Upon information and belief, after the Hewlett-Packard legal department approved the final draft of the application for filing, after which I again reviewed the application and signed the formal documents required for filing the application.

EXHIBIT B
PAGE 1 OF 1